

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 7, 2010. At the time of the Final Office Action, Claims 23-40 were pending in this Application, and Claims 1-22 were previously cancelled without prejudice or disclaimer. All pending Claims 23-40 were rejected in the Final Office Action. Applicants respectfully requests reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. §103

Claims 39-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* (U.S. Patent No. 6,101,393) in view of *Bedingfield* (U.S. Patent Application No. 2002/0110227), further in view of *Lazaridis* (U.S. Patent Application Publication No. 2004/0157590).

Claims 23-38, 30-36 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of *Bedingfield* and further in view of 3G TS (3G TS 23.140 V3.0.1. (2000-03) 3rd Generation Partnership Project; Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional Description) and *Lazaridis*

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination

was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

In all claim rejections under 35 USC §103, the Examiner used reference *Lazaridis* as prior art. Applicant respectfully disagrees. *Lazaridis* is not an appropriate prior art under 35 USC §103. The present application, has a US filing date as of July 7, 2003 and claims priority to European application EP02017412 filed on August 2, 2002.

Lazaridis has a filing date of October 31, 2003. Even though *Lazaridis* claims priority to provisional application No. 60/440363 which was filed on January 16, 2003, the Examiner cited from the non-provisional application which is not prior art because its filing date lies after the filing date of the present application. The Examiner failed to show that the *Lazaridis* is identical to the provisional application to which *Lazaridis* claims priority. A patent claiming priority to a provisional application can be a prior art reference under §102(e) when all subject matter relied upon for a rejection is found in both the patent and the provisional application. *Ex parte Yamaguchi* (USPTO/BPAI, August 28, 2008). The Examiner failed to provide any statement that *Lazaridis* and its underlying provisional application both disclose the limitation on which the Examiner bases his rejection. Hence, applicant believes that all claim rejections are improper.

Moreover, Applicant intends to perfect the priority claim by submitting a translation of the priority documents and a statement that the translation is accurate, which will exclude *Lazaridis* entirely as prior art.


CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2025.

Respectfully submitted,
KING & SPALDING L.L.P.
Attorneys for Applicants


Andreas H. Grubert
Registration No. 59,143

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SEND CORRESPONDENCE TO:
KING & SPALDING L.L.P.

CUSTOMER ACCOUNT NO. **86528**
512.457.2025
512.457.2100 (fax)